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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,144	11/18/2003	Theodore F. Emerson	200303930-4	5291

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EXAMINER	
SHIN, CHRISTOPHER B	

ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/716,144	EMERSON ET AL.	
	Examiner	Art Unit	
	Christopher B. Shin	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-50* is/are pending in the application.

4a) Of the above claim(s) *See Continuation Sheet* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,5,7,9,14,16,21,23,25,30,33,38,40,45,47 & 49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11182003 (*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 2,4,6,8,10-13,15,17-20,22,24,26-29,31,32,34-37,41-44,46,48,50 and 396.

DETAILED ACTION

1. The Response to Restriction received September 28, 2005 has been entered and carefully considered. The applicant stated that "withdraw claims 2, 4, 6, 8, 10-13, 15, 17-20, 22, 24, 26-28, 31-32, 34-37, 39, 41-44, 46, 48, and 50; the examiner believe that the claims 26-28 should have been 26-29.

Election/Restrictions

2. Applicant's election with traverse of claims 1, 3, 5, 7, 9, 14, 16, 21, 23, 25, 30, 33, 38, 40, 45, 47 & 49 in the reply filed on September 28, 2005 is acknowledged.

3. Claims 2, 4, 6, 8, 10-13, 15, 17-20, 22, 24, 26-29, 31-32, 34-37, 39, 41-44, 46, 48 & 50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on September 28, 2005.

The examiner notes that the applicant did not provide clear arguments reasons to support the Restriction Requirement; therefore, the Requirement is made Final.

As you can see from the restriction requirement, the restriction requirement was not given to eliminate claims, but to find the allowable independent claimed limitation so that the examination process can be expedited without burdening the examiner. Once the allowable subject matter is determined, all of the species can also be allowed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 5, 9, 16, 23, 30, 33, 40 & 47 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Emerson et al. (6,476,854).

a. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any

invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

b. In figure 1 and the respective description sections teaches all of the claimed limitations; therefore, the claimed invention would have been clearly anticipated by the Emerson reference. It appears that the one of the common inventor should know the details teachings of the Emerson reference; therefore, no details teachings deem necessary. Furthermore, one skilled in the art should know the same teachings of Emerson reference an the claimed invention.

6. Claims 1, 5, 9, 16, 28, 30, 33, 40 & 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Rao et al. (6,321,287).

c. Rao teaches all of the limitations of the claims as follows:

Claims 1, 5, 9, 16, 23, 30, 33, 40 & 47
Rao et al.

- A computer system, comprising
  - Feature of figure 1
- Expansion slot
  - Feature of slots that receives (301)
- Managed computer system
  - Feature of (101) above and right of (121)
- a bus for interconnecting a managed computer system with an expansion slot;
  - feature of PCI BUS (120), figure 1
- an expansion board comprising a processor, the board disposed in the expansion slot; and
  - feature of figure (301)
- a processor
  - feature of Controller (205) of figure 3
- a remote console functionality assist logic structure controlled by the processor to provide video signals generated by the managed computer system to a remote computer system.
  - Feature of (121,123,131,133), figure 1

d. Since the Rao reference teaches all of the limitations of the claims, the claimed limitations would have been anticipated by the teachings of the Rao reference.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 3, 7, 14, 21, 25, 38, 45 & 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rao et al. (6,321,287).

e. The teachings of the parent claims 1, 5, 9, 16, 23, 30, 33, 40 & 47 are similarly applied in this rejection.

f. As for claims 3, 7, 14, 21, 25, 38, 45, 49, the Rao reference does not expressly disclose the limitation regarding the video encoder being part of the remote console; however, this is an well known design choice matter that are commonly practiced in the art of video processing art. The present application pages 14-15 & 23 also support the video encoder is provided, as "an enhancement, although it is not essential", "is generally provided for enhanced functionality such as video playback, etc". One skilled in the art can easily add such functional enhancement when desired. See also cited references Potu et al. (5,812,144) and Stephenson et al. (6,134,613), as an example. Therefore, it

would have been obvious at the time the invention was made to one having ordinary skill in the art to add such commonly known –commonly practiced enhancement to the Rao's system for the well-known motivation of functionally enhancement such as video playback, etc.

Double Patenting

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1, 3, 5, 7, 9, 14, 16, 21, 23, 25, 30, 33, 38, 40, 45, 47 & 49 are rejected on the ground of nonstatutory double patenting over claims1-32 of U. S. Patent No. 6,742,066 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

The elected claims recite substantially identical claims as the above Patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

13. Claims 1, 3, 5, 7, 9, 14, 16, 21, 23, 25, 30, 33, 38, 40, 45, 47 & 49 are rejected on the ground of nonstatutory double patenting over claims 1-6 of U. S. Patent No. 6,385,682 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

The elected claims recite substantially identical claims as the above Patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher B. Shin whose telephone number is 571-272-4159. The examiner can normally be reached on 6:30-5:00 M,Tu,Th,F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Shin
Primary Examiner
Of 2182

November 29, 2005
cbs